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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,463	04/21/2005	Atsushi Nakayama	Q8-4985	2865
23373 7590 09/30/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
NERANGIS, VICKIEY MARIE				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
09/30/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/516,463

Applicant(s)

NAKAYAMA ET AL.

Examiner

Vickey Nerangis

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 6/23/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/17/2009 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 103

3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholl et al (Us 5,663,226).

The rejection is adequately set forth in paragraph 4 of Office action mailed on 11/17/2008 and is incorporated here by reference.

Response to Arguments

4. Applicant's arguments filed 2/17/2009 and 7/17/2009 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Scholl et al fails to disclose different lengths of sulfur (e.g., $m \neq x$) in the silane compound and (B) that the declaration filed on 7/17/2009 establishes unexpected results for the instant invention.

With respect to argument (A), while Scholl only uses one symbol "x" to represent the presently claimed "m," "x," "y," and "z," such does not necessarily suggest that Scholl et al only discloses one length of distinct sulfur linkages in the silane compound. Note example 7 which has an x value of both 1 and 4.

With respect to argument (B), this discussion will be separate out based on claim 1 (and claims dependent thereon) and claim 13 (and claims dependent there).

Concerning claim 1, the data in Table B is insufficient to establish unexpected results for two reasons. First, the data is not a proper side-by-side comparison. When comparing inventive examples 5 and 6 to comparative example E, the molar amount of coupling agent is significantly higher in the comparative examples. Therefore, it is not clear if the differences in Mooney viscosity, Mooney scorch time, elongation and tensile strength at break, and abrasion resistance are due to the type of silane compound. Second, the data is not reasonably commensurate in scope with the scope of the claims for two reasons. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). First, the comparison is only for silane compounds including formula (III) and not formula (IV). Second, the data which discloses R⁶ and R⁷ that is hexylene or decylene is not reasonably commensurate in scope with the claimed R⁶ to R¹⁰ groups that can also be divalent aromatic groups or divalent hetero atom-containing groups. There is nothing on the record to show that hexylene or decylene is functionally equivalent to divalent aromatic groups or divalent hetero atom-containing groups.

Concerning claim 13, the data in Table A is insufficient to establish unexpected results for two reasons. First, the data is not a proper side-by-side comparison. When comparing

inventive example 2 to comparative examples A, B, and C, the molar amount of coupling agent is significantly higher in the comparative examples. Therefore, it is not clear if the differences in Mooney viscosity, Mooney scorch time, elongation and tensile strength at break, and abrasion resistance are due to the type of silane compound. Second, the data which discloses R⁵ that is decylene is not reasonably commensurate in scope with the claimed R⁵ that can also be phenylene or methylphenylethylene. There is nothing on the record to show that decylene is functionally equivalent to phenylene or methylphenylethylene.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Nerangis whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/516,463
Art Unit: 1796

Page 5

9/30/2009

/Vickey Nerangis/
Primary Examiner, Art Unit 1796